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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
09/927,851	08/10/2001	Ross Elgart	RELGART.001A	7081

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EXAMINER

VEILLARD, JACQUES

ART UNIT	PAPER NUMBER
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2175

DATE MAILED: 07/12/2004

Please find below and/or attached an Office communication concerning this application or proceeding.

Office Action Summary

Application No.

09/927,851

Applicant(s)

ELGART, ROSS

Examiner

Jacques Veillard

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-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --
Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 03 May 2004.
- 2a) ☒ This action is **FINAL**. 2b) ☐ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 1-25 and 32-39 is/are pending in the application.
- 4a) Of the above claim(s) _____ is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☒ Claim(s) 1-25 and 32-39 is/are rejected.
- 7) ☐ Claim(s) _____ is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on _____ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some * c) ☐ None of:
- ☐ Certified copies of the priority documents have been received.
 - ☐ Certified copies of the priority documents have been received in Application No. _____.
 - ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- | | |
|--|---|
| 1) <input type="checkbox"/> Notice of References Cited (PTO-892) | 4) <input type="checkbox"/> Interview Summary (PTO-413)
Paper No(s)/Mail Date. _____ |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948) | 5) <input type="checkbox"/> Notice of Informal Patent Application (PTO-152) |
| 3) <input type="checkbox"/> Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08)
Paper No(s)/Mail Date _____ | 6) <input type="checkbox"/> Other: _____ |

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DETAILED ACTION

1. This action is responsive to the Applicant's communication filed on 5/3/2004.
2. Claims 1, 19, 32-35 have been amended, claims 26-31 canceled, and claims 36-39 added.
3. Claims 1-25 and 32-39 are pending and presented for examination.

Response to Arguments

4. Applicant's arguments filed on 11/6/2003 with respect to 1, 10, 17, 19, 23, 28, and 29 (Paper No.5) have been fully considered but they are not persuasive for the reason set forth below.

Claim Rejections - 35 USC § 112

5. The following is a quotation of the second paragraph of 35 U.S.C. 112:

The specification shall conclude with one or more claims particularly pointing out and distinctly claiming the subject matter, which the applicant regards as his invention.

6. Claims 1-25, and 32-39 are rejected under 35 U.S.C. 112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which applicant regards as the invention.

Regarding claims 1, 19, and 32-39, the phrase "**description of the physical**" renders the claims indefinite because it is unclear whether the limitation(s) following the phrase are part of the claimed invention. See MPEP § 2173.05(d).

The same rejection occurs for claims 2-18, 36, 37, and 20-25, 38, 39 by virtue of dependency to the independent claims 1 and 19.

7. The following is a quotation of the first paragraph of 35 U.S.C. 112:

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The specification shall contain a written description of the invention, and of the manner and process of making and using it, in such full, clear, concise, and exact terms as to enable any person skilled in the art to which it pertains, or with which it is most nearly connected, to make and use the same and shall set forth the best mode contemplated by the inventor of carrying out his invention.

8. Claims 1-25, and 32-39 are rejected under 35 U.S.C. 112, first paragraph, as failing to comply with the written description requirement. The claim(s) contains subject matter, which was not described in the specification in such a way as to reasonably convey to one skilled in the relevant art that the inventor(s), at the time the application was filed, had possession of the claimed invention.

Regarding claims 1, 19, and 32-35 it is unclear for the examiner to find a concise explanation in the specification for the phrase “**description of the physical**”. The phrase “**description of the physical**” is not described in the specification in such a way as to reasonably convey to one skilled in the relevant art that inventor(s), at the time the application was filed, had possession of the claimed invention.

Claims 2-18, 36, 37, and 20-25, 38, 39, suffers the same deficiency by virtue of dependency to the independent claims 1 and 19.

9. The new matter that has been entered into the claims such as (“**description of the physical**”) affects the scope of the claims (claims must read in combination of the drawings). Therefore, the rejection of claims 1-25 and 32-39 under 35 U.S.C. 112, first paragraph is proper, because the new matter is not described in the application as originally filed. See MPEP 608.04.

More specifically, the specification as originally filed has no support for the limitation: “description of the physical location” as recited in independent claims 1, 19, 32-35, and the dependent claims 2-18, 36, 37, and 20-25, 38, 39.

Response to Applicant's remarks

10. The Examiner has completed a thorough study of Applicant's remarks. On pages 9 and 10 of the remarks Applicant argues that the cited references Lenk et al. (U. S. Pat. No. 6,366,923, hereinafter Lenk) and Cassorla et al. (U. S. Pat. No. 5,146,552, hereinafter Cassorla) do not disclose, teach or suggest a "**description of the physical** location of a hardcopy document in a database" and the claims are not obvious in view of Lenk and Cassorla.

In response to Applicant's remarks the examiner notes that, the limitation on which the Applicant relies (i.e., "**description of the physical** location") is not stated in the claims as original filed.

Furthermore applicant argued that claims 1, 19, and 32-35 are not obvious and there are no reasons to combine Lenk (U.S. Pat. No. 6,366,923) in view of Cassorla (U. S. Pub. No. 5,146,552). In response to applicant's remarks and as the claims recite originally, the examiner recognizes that references can not be arbitrarily combined and that there must be some reason why one skilled in art would be motivated to make the proposed combination of primary and secondary references. *In re Nomiya, 184 USPO 607 (CCPA 1975)*. However, there is no requirement that a motivation to make the modification be expressly articulated. The test for combining references is what the combination taken, as a whole would suggest to one of ordinary skill in the art. *In re McLaughlin, 170 USPO 209 (CCPA 1971)*. References are evaluated by what they suggest to one versed in the art, rather than by their specific disclosures. *In re Bozek, 163 USPO 545 (CCPA 1969)*. In this case, at the time of the Applicant's invention, it would have been obvious to one of ordinary skill in the art to use the annotation with electronically published document taught by Cassorla to modify the teachings of Lenk to include

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the electronic book and hardcopy book feature with the motivation for a user to add notes and output a hardcopy using a browser's command (See Lenk's col.6, lines 35-36).

Therefore, the examiner asserts that the cited prior arts (Lenk, U. S. Pat. No. 6,366,923) in combination with (Cassorla, U. S. Pat. No. 5,146,552) teach or suggest the subject matter broadly recited in claims 1, 19, and 32-35 and dependency as required under 35 U.S.C. 103 (a).

The examiner disagrees with the applicant and maintains all rejection with respect to the original included amended claims 1-25, and 32-35. All the arguments have been considered. It is the examiner's conclusion that the amended claims 1, 19, and 32-35 and original 2-18, 20-25 are not patentably distinct or non-obvious over the prior art of record (See the action mailed on 7/15/2003).

Claim Rejections - 35 USC § 103

11. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

12. Claims 1-25, 32-35, 37, and 39 are rejected under 35 U.S.C. 103(a) as being unpatentable over Lenk et al. (U.S.Pat. No. 6,366,923, hereinafter Lenk) in view of Cassorla et al. (U.S.Pat. No. 5,146,552, hereinafter Cassorla).

As per claim 1, Lenk teaches a system for conducting research on the Internet by accessing a pre-selected web site on a computer network (See Title and abstract lines 1-3).

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Similarly, the system taught by Link enabling a user to enter comments about an Internet link (See col.1, lines 61-67, and col.4, lines 11-13); storing the entered comments about the Internet link and a URL of the Internet link in an Internet link record in a database (See col. 1, lines 56-60, and col.3, lines 42-57); associating the Internet link record with a category or an item (See Fig.4C component 25); and making the Internet link record, the electronic file record, and the hardcopy document record accessible to other users that use the database (See col. 1, lines 19-29), wherein the Internet link record, the electronic file record, and the hardcopy document record can be associated with a same category or a same item (See Fig. AB, and col.5, lines 18-22). Link does not explicitly teach the system for enabling the user to enter comments about an electronic file storing the entered comments about the electronic file and a file access path of the electronic file in an electronic file record in the database; associating the electronic file record with a category or an item; enabling the user to enter comments about a hardcopy document; storing the entered comments about the hardcopy document and a description of the physical location of the hardcopy document in a hardcopy document record in the database; associating the hardcopy document record with a category or an item.

However, Cassorla in the same endeavor, teaches a method for associating annotation or note with electronic material documents (See Title and abstract) includes the feature for enabling the user to enter comments about an electronic file (See abstract lines 1-4, lines 17-23, col.2, lines 20-23); storing the entered comments about the electronic file and a file access path of the electronic file in an electronic file record in the database (See abstract lines 4-6, and col.2, lines 23-25, and lines 45-48); associating the electronic file record with a category or an item (See col.3, lines 19-35); enabling the user to enter comments about a hardcopy document (See col. 1,

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lines 61-66); storing the entered comments about the hardcopy document and a description of the physical location of the hardcopy document in a hardcopy document record in the database (See abstract lines 6-12, col.2, lines 25-31, lines 45-54, col.3, lines 16-24, and col.5, lines 31-53 “Cassorla provides a method which permits a user or reader of an electronically published document to create notes, bookmarks, or annotations and relate them to a particular location in the document. That particular location corresponds to a physical description of the location where the notes, bookmarks or annotations were stored”); associating the hardcopy document record with a category or an item (See col.2, lines 35-41).

Lenk and Cassorla are combinable because they are from the same field of endeavor: create notes or annotation in a document.

The combination of Lenk and Cassorla disclose the claimed invention except for a description of the physical location, therefore, it would have been obvious to a having ordinary skill in the art at the time of the Applicant's invention was made to modify the teachings of Lenk with the annotation and notes with electronically published document taught by Cassorla since it was known in the art that annotation and notes with electronically published document determine a description of the physical location of the documents. The motivation being to enable users to mark up material and identify major document elements such as chapters, sections sub-sections, paragraphs (See Cassorla's col.2, lines 18-25 and lines 35-44).

As per claims 19, 33, and 35, the claims have substantially the same limitations as claim 1. These limitations are already addressed in the rejection of claim 1. Therefore, they are rejected on similar grounds corresponding to the arguments given for claim 1 rejection above. In addition,

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Link teaches a category records, wherein a category can be a sub-category of another (See Fig.2, and col.3, lines 26-35).

As per claims 32, and 34, the claims have substantially the same limitations as claim 1. These limitations are already addressed in the rejection of claim 1. Therefore, they are rejected on similar grounds corresponding to the arguments given for claim 1 rejection above. In addition, Lenk teaches the feature enabling a user to navigate to an Internet link and electronic file using a web browser (See Lenk's Figs 4A-4F, and col.4, line 64 through col.6, line 33). Lenk achieves this limitation by providing a browser and a computer-implemented search program as a search engine wherein users have the capability of navigating back and forth to access information and find useful information pertinent to their interest.

13. For the rejection of claims 2-18, 20-25, (See the action mailed on 7/15/2003).

14. As per claims 37 and 39, the combination of Lenk and Cassorla, as modified, teaches the claimed invention, wherein the description of the physical location of the hardcopy document comprises a description of a book title and/ or a page number at which the hardcopy document is located (See Cassorla's col.2, lines 25-31 "the name associated with the document may be a book title or simply a title").

Allowable Subject Matter

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15. Claims 36 and 38 objected to as being dependent upon a rejected base claim, but would be allowable if rewritten in independent form including all of the limitations of the base claim and any intervening claims.

16. The following is a statement of reasons for the indication of allowable subject matter:

The prior art taken singularly or in combination fails to teach or suggest a method or system wherein the description of the physical location of each of the plurality of hardcopy documents comprises a description of a room and/or a drawer in which the hardcopy documents are located as recited in claims 36 and 38..

17. Applicant's amendment necessitated the new ground(s) of rejection presented in this Office action. Accordingly, **THIS ACTION IS MADE FINAL**. See MPEP § 706.07(a). Applicant is reminded of the extension of time policy as set forth in 37 CFR 1.136(a).

A shortened statutory period for reply to this final action is set to expire THREE MONTHS from the mailing date of this action. In the event a first reply is filed within TWO MONTHS of the mailing date of this final action and the advisory action is not mailed until after the end of the THREE-MONTH shortened statutory period, then the shortened statutory period will expire on the date the advisory action is mailed, and any extension fee pursuant to 37 CFR 1.136(a) will be calculated from the mailing date of the advisory action. In no event, however, will the statutory period for reply expire later than SIX MONTHS from the date of this final action.

18. **Any response to this action should be mail to:**

Commissioner of Patent and Trademarks

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Washington, D.C. 20231

Or faxed to:

(703) 746-7239 (for formal communication intended for entry)

Or:


(703) 746-7240 (for informal of draft communications, please label

“PROPOSED” or “DRAFT”)

Hand - delivered responses should be brought to Crystal Park II, 2021 Crystal Drive, Arlington, VA, Fourth Floor Lobby (Receptionist Telephone No. (703) 305-3900).

19. Any inquiry concerning this communication or earlier communications from the examiner should be directed to Jacques Veillard whose telephone number is (703) 305-7094. The examiner can normally be reached Monday through Friday from 9:30 AM to 4: 30 PM.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Dov Popovici, can be reached on (703) 305-3830. The fax phone number for this group is (703) 308-5403.


CHARLES RONES
PRIMARY EXAMINER



Jacques Veillard
Patent Examiner TC 2100

June 30, 2004